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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,206	03/17/1999	JOSEPH C. KAWAN	CIITI0096	3773
27510	7590	10/03/2003	EXAMINER	
KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. SUITE 900 WASHINGTON, DC 20005			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/271,206

Applicant(s)

KAWAN, JOSEPH C.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07/02/03 (Response).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-13,15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5-12 and 23 is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response***

1. Receipt is acknowledged of the response filed on July 2, 2003. Claims 1-3, 5-13, and 15-  
5 23 remain for examination.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
manner in which the invention was made.

- 15 3. Claims 13 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
Kitahara (US 5,821,515, of record) in view of Furuhashi et al. (US 6,029,887, of record) and  
Barakat (US 4,910,774).

Kitahara teaches a method and device for reading and writing to a multi-memory  
20 card, in specific, positioning a first memory 1A of a card within a first read/write component 29  
to be read from or written to and positioning a second memory 1B of the card within a second  
read/write component 48 to be read from or written to (see figures 1 and 2). The first memory  
1A is an optical memory area, wherein transport motor device 12 conveys the card into a first  
position to be read by read/write head 29. The second memory 1B is an electrical IC chip,  
25 wherein, after the memory 1A is read, motor 12 transports the card into a second position.  
Solenoid 51 is used by controller 54 to engage read/write head 48 with the memory 1B (figures 3

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and 4). Position sensors 36 and 37 detect the position of the card for reading/writing. It is taught that a central control circuit (Central Processor Unit) drives the motor and components (col. 5, lines 19-25 and lines 63-65).

It is not specified, however, the card having a third memory, the device employing a third  
5 read/write component for reading said memory.

Furuhashi teaches a transaction card 1 containing IC (first) memory 11, optical (second) memory 13, and magnetic (third) memory 14 (see figure 1 and col. 11, lines 53-64). During use by a cardholder, the card's memories are read and written to by interface between the holder and a payee entry device. The device contains a display 143, input means 141, and an apparatus 145  
10 for reading and writing to the memory(s) of the card (figures 13 and 14).

It would have been obvious to one of ordinary skill in the art to provide a third means of memory in addition to the first and second memory of the card of Kitahara, as it would inherently add more memory space upon the card and provide greater options and versatility to the holder of the card. It would allow the user to obtain and access a greater number of accounts  
15 and/or account data, use the card at greater plurality of reader terminals, etc. Kitahara states that the card may also employ a magnetic memory area, in which a read/write head would be present in place of the optical head 29 (see Kitahara, col. 10, lines 5-11). This depicts that the device of Kitahara may also contain mechanical means of reading/writing to the magnetic stripe on the card. With the teachings of Furuhashi, it would have been an obvious expedient to one of  
20 ordinary skill to add such means to facilitate the reading and writing of data to all three types of memories that would be available on the card.

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Kitahara as modified by Furuhashi, however, fail to show the control device as generating a key at the electronic memory for encrypting writing on the optical memory.

Barakat teaches a memory card that uses at least 3 memory areas (one area including electrical memory), whereas when the card is initialized, a device generates a key within a first  
5 memory of the card, the key encrypting data written to a second memory of the card (see figure 1, abstract, and col. 4, line 65 – col. 5, line 26).

While Barakat does not specifically teach the use of magnetic and optical memory in addition to the electrical memory, it would have been obvious to one of ordinary skill in the art to provide the concept of generating a key in a first memory area to encrypt a second memory as  
10 such an expedience adds security to the data within the card. Generating the key in the first (electrical) memory allows the algorithm for obtaining data to be specific to the card. If a predetermined key were assigned to a plurality of keys, a thief could steal one key of data on one card and compromise data from the rest of the plurality. With the key generated by the first memory of the specific card, the data of the second (optical) memory area would be more secure  
15 to fraudulent users.

***Allowable Subject Matter***

4. Claims 1-3, 5-12, and 23 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter: the  
20 claims are directed a method and a system for controlling the reading from and writing to multi-memory card. The multi-memory is comprised of magnetic memory, optical memory, and electronic memory. As have been indicated in previous Office Action(s) the card containing

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magnetic, optical and electronic storage means are well known in the art, and widely used in various embodiments. However, the cited references, taken alone or in combination, fail to show or fairly teach the specific method wherein the first memory is read, and user-selectable functions are provided based on first-reading via user interface (i.e., menu), and the selected function further directs in the reading of the second memory. This process is cascaded from the second memory to the third memory as set forth in the claims.

### ***Response to Arguments***

The Applicants' response filed on July 2, 2003 have been carefully reviewed and considered.

In considering Applicant's remarks and the prior arts cited, the Examiner agrees with Applicants position that the cited references does not teach the particular method the first memory and second memory and third memory are being read. Accordingly, the limitations are now indicated as an allowable subject matter.

However, with respect to claim 13 and its dependent claims, it is the Examiner's view that the cited references still read on the subject matter disclosed in these claims. Examiner further notes that the Applicants filed response without amending any claims (see paragraph 3 above). In view of the above, this Office Action is made non-final.

### ***Conclusion***

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I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Yoshida (US 5,895,909); Gutman et al. (US 5,834,756) disclose card carrying magnetic/optical/electronic storage area and the methods for using such cards.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

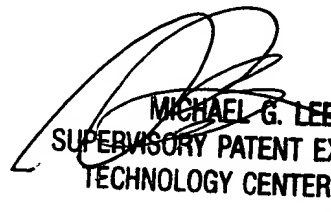
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Patent Examiner  
Art Unit 2876  
September 12, 2003



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